

## **REMARKS**

### **Interview**

Applicant would like to thank the Examiner for the courtesy extended to Applicant's attorney during the interview on December 23, 2008. The amendments and remarks submitted herein are consistent with the topics discussed during the interview.

### **Status of the Claims**

Claims 1, 5-30, and 35-68 are pending in this application. Claims 1, 27, 54-56, 61, and 68 are independent. In the Office Action, claims 9 and 66-68 were rejected under 35 U.S.C. § 112, first paragraph. In addition, claim 14 was rejected under 35 U.S.C. § 112, second paragraph. Also, claims 1, 5-11, 14-18, 27, 36-44, 47-52, 54-57, 59, 60, and 65-68 were rejected under 35 U.S.C. §102(b) as being allegedly anticipated by CA 2186042 to Gueret (hereinafter "the '042 patent"). Further, claims 19-26, 28-30, 35, 45, 46, 53, and 58 were rejected under 35 U.S.C. § 103(a) as being allegedly unpatentable over the '042 patent in view of Kochinke (U.S. Patent No. 5,350,581; hereinafter "Kochinke"). Finally, claims 12, 13, and 61-64 were rejected under 35 U.S.C. § 103(a) as being allegedly unpatentable over the '042 patent in view of Yoko (JP 04108710; hereinafter "Yoko").

Applicant has amended claims 9 and 14 to overcome rejections under § 112, by removing certain recitations from these claims. In addition, Applicant has amended independent claims 1, 27, 54, 55, and 61 to specify that at least one of the two non-adhesive layers is permeable to a solvent and defines an outer surface of the composite structure. Applicant respectfully submits that written description support for these amendments to claims 1, 27, 54, 55, and 61 is provided in the specification, for example, at page 9, lines 17-20.

## **Rejection Under 35 U.S.C. § 112, First Paragraph**

### **Claim 9**

In the Office Action, claim 9 was rejected under 35 U.S.C. § 112, first paragraph, because the specification allegedly fails to comply with the written description requirement, due to an alleged lack of adequate description for the term “freeze-dried substances.” Office Action at 4. Although Applicant respectfully disagrees with this rejection, Applicant has, in the interest of expediting prosecution, amended claim 9 to remove the term “freeze-dried substances.” In view of this amendment, Applicant respectfully submits that the rejection of claim 9 under § 112, first paragraph, should be withdrawn.

### **Claims 66-68**

Claims 66-68 also were rejected under § 112, first paragraph, because the claim limitation specifying that the composite structure has a “substantially constant thickness” is allegedly not supported in the original disclosure. Office Action at 2-4. Applicant respectfully submits that this limitation is supported by at least the originally filed drawings and that, therefore, the § 112, first paragraph, rejection of claims 66-68 should be withdrawn.

The Office Action cites several passages in Applicant’s specification, which describe exemplary embodiments of the disclosed composite having support layers that “can be of different thicknesses.” Office Action at 3. The Examiner also alleged, in the Office Action at page 4 and during the interview, that some of the drawing figures in the application purportedly show “layers having different thicknesses,” “thickness that varies

along the length of the illustrated article,” “very small scale differences in thickness along the length of the illustrated article,” and/or “merely a portion of a whole article.”

With respect to the allegations regarding the layers of the disclosed article, Applicant respectfully submits that it is irrelevant whether some layers have a different thickness than other layers or whether layers vary along the length of the article because each of claims 66-68 requires that the composite structure (not its subparts) has a substantially constant thickness. Also, whether or not there are small scale differences along the length of the illustrated article is also irrelevant because each of claims 66-68 requires that the composite structure has a substantially constant thickness.

Applicant also respectfully disagrees with the lack of written description allegation based on an assertion that the figures show merely a portion of a whole article. First, Applicant respectfully submits that certain figures in Applicant’s application illustrate a truncated article, while others do not. Second, there is nothing in the specification that suggests the non-truncated composite structures shown in the figures are representations of only portions of those composite structures. Third, there are, in fact, descriptions in the specification indicating that one or more of Applicant’s figures illustrate a complete article.

While figures 14 and 15 show curvy lines at each end, indicating that the article has been truncated for purposes of illustration, the composite structures shown in figures 1-10 do not include such curvy lines. There is nothing in the specification that would indicate any of figures 1-10 depict merely a portion of an article. In fact, the specification indicates that particular types of composite structures having the

configurations of figures 1-10 are contemplated. For example, the specification indicates, at page 9, lines 27-28, that “[b]y way of example, a cleaning disk has been made having structure as shown in Figure 2.” Therefore, it is clear that not only does Figure 2 illustrate an article as a whole, but it is also clear, from inspection of the drawing, that the illustrated composite structure has a substantially constant thickness.

For at least these reasons, Applicant respectfully submits that the original disclosure supports the claim term “substantially constant thickness.” Accordingly, Applicant submits that the § 112, first paragraph rejection of claims 66-68 should be withdrawn.

#### **Rejection Under 35 U.S.C. § 112, Second Paragraph**

In the Office Action, claim 14 was rejected under 35 U.S.C. § 112, second paragraph, because the claim allegedly recites a broad range and a narrow range that falls within the broad range. Office Action at 6. The Office Action alleges that the term “vinyl” is a broad limitation and that the terms “PVP” and “PVA” are narrow limitations falling within the scope of the term “vinyl.” Office Action at 7. While Applicant does not necessarily agree with this rejection, in order to expedite prosecution, Applicant has amended claim 14 to remove the term “vinyl.” Applicant respectfully submits that, in view of this amendment, the rejection of claim 14 under § 112, second paragraph, should be withdrawn.

#### **Rejection under 35 U.S.C. §102(b)**

Applicant respectfully submits that the rejection of claims 1, 5-11, 14-18, 27, 36-44, 47-52, 54-57, 59, 60, and 65-68 under 35 U.S.C. §102(b) should be withdrawn because the ‘042 patent fails to disclose all the recited features of independent claims 1, 27, 54-56, and 68.

Independent Claim 1

For example, the '042 patent does not disclose a composite structure for at least one of treating, making up, and cleaning a surface region, the composite structure comprising, among other things,

at least two non-adhesive layers, at least one of the two non-adhesive layers being permeable to a solvent and defining an outer surface of the composite structure, the outer surface being configured to be placed into contact with the surface region . . . [and]

at least one adhesive matrix between the two non-adhesive layers, the adhesive matrix comprising a permanent adhesive, the two non-adhesive layers being permanently bonded to the adhesive matrix,"

as recited in amended independent claim 1. Emphasis added.

The Office Action alleges that the '042 patent discloses a patch comprising an "occlusive support layer . . . [a] protective layer and [a] polymer matrix." Office Action at 8. The "protective layer" mentioned in the Office Action apparently refers to the "detachable layer of protection," which is mentioned on page 7 of the '042 patent, in the third paragraph from the bottom. During the interview, the Examiner alleged that the '042 patent disclosed a permanent adhesive. However, as ultimately acknowledged by the Examiner during the interview, regardless of whether the matrix of the '042 patent includes a permanent adhesive, the detachable layer of protection cannot be equated with one of the claimed non-adhesive layers, because the adhesive matrix cannot be permanently bonded to the detachable layer of protection. If it were, the layer of protection would not be detachable.

In what appears to be an alternative argument, the Office Action also alleged that a "nylon net" or "mesh" disclosed in the '042 patent, in the fourth paragraph from the

bottom of page 7, constitutes a second non-adhesive layer permanently bonded to the adhesive matrix. The '042 patent does not disclose, however, that an adhesive matrix is disposed between the nylon net and the occlusive support layer. It appears that the nylon net in the '042 patent is embedded in a matrix. If the nylon net is positioned in contact with the support layer (i.e., if the nylon net is recessed all of the way in the matrix and into contact with the support layer), the matrix would not be between the nylon net and the occlusive support layer. There is no disclosure in the '042 patent that suggests the nylon net is placed in any other location.

Furthermore, the configuration of the '042 patent differs from the composite structure recited in claim 1 in that the nylon net, alleged in the Office Action to constitute a second non-adhesive layer, does not define an outer surface configured to be placed in contact with a surface region. The '042 patent discloses a self-adhesive transdermal skin patch, including a "self-adhesive" reservoir layer (i.e., the layer considered by the Examiner to constitute an adhesive matrix). See, e.g., abstract and page 7, third paragraph from the bottom. Therefore, it appears that the matrix of the patch disclosed in the '042 patent is an outer, skin-contacting layer, and that the nylon net is embedded in the matrix and not adhered to the outer surface of the matrix. Thus, the '042 patent fails to disclose "at least one of the two non-adhesive layers being permeable to a solvent and defining an outer surface of the composite structure, the outer surface being configured to be placed into contact with the surface region," as recited in independent claim 1, as amended.

For at least these reasons, Applicant respectfully submits that the § 102(b) rejection of independent claim 1 based on the '042 patent should be withdrawn.

### Independent Claims 27 and 54-56

Each of independent claims 27, 54, and 55 has been amended to include recitations corresponding to those discussed above in connection with claim 1. In addition, independent claim 56 includes similar recitations, specifying that the “support layers [form] external faces of the structure.” Therefore, the rejections of independent claims 27 and 54-56 under § 102(b) should be withdrawn for substantially the same reasons as those discussed above with respect to claim 1.

### Independent Claim 68

With regard to independent claim 68, Applicant respectfully submits that the ‘042 patent fails to disclose a composite structure having, among other things, “a substantially constant thickness,” as recited in claim 68. The ‘042 patent discloses that the composite structure can be obtained by cutting the desired forms, which produces pinched edges. Page 7, line 22. Applicant respectfully submits that, since the composite structure in the ‘042 patent is disclosed to have pinched edges, the composite structure does not have a “substantially constant thickness,” as required by claim 68. For at least this reason, Applicant submits that the § 102(b) rejection of independent claim 68 should be withdrawn.

### Rejection of Claims 61-64 Under 35 U.S.C. § 103(a)

#### Claim 61

The rejection of claims 61-64 under § 103(a), based on ‘042 patent in view of Yoko, fails to establish a prima facie case of obviousness, because the cited art does not disclose or suggest all of the recitations of independent claim 61. Claim 61 has been amended to include recitations similar to those discussed above for independent

claim 1. That is, claim 61 has been amended to recite “at least one of the two support layers being permeable to a solvent and defining an outer surface of the composite structure, the outer surface being configured to be placed into contact with the surface region.” Thus, claim 61 is distinguishable over the ‘042 patent for reasons similar to those discussed above with respect to independent claim 1.

Yoko is cited only for an alleged teaching of a “cosmetic in adhesive matrix comprising magnetizable particles,” (Office Action at 11), and fails to cure the above-noted deficiencies of the ‘042 patent. Therefore, the cited art does not disclose or suggest all of the recited features of independent claim 61, and thus, the Office Action fails to establish a prima facie case of obvious with respect to claim 61. Accordingly, Applicant respectfully submits that the § 103(a) rejection of independent claims 61-64 should be withdrawn.

**Rejection of Dependent Claims 12, 13, 19-26, 28-30, 35, 45, 46, 53, and 58 Under 35 U.S.C. § 103(a)**

Claims 12 and 13, each of which ultimately depends from claim 1, were rejected under § 103(a) based on the ‘042 patent and Yoko. As noted above, Yoko is cited solely for an alleged teaching of a “cosmetic in adhesive matrix comprising magnetizable particles,” (Office Action at 11), and does not cure the deficiencies of the ‘042 patent discussed above with respect to claim 1. Accordingly, Applicant respectfully submits that the § 103(a) rejection of dependent claims 12 and 13 should be withdrawn.

Claims 19-26, 28-30, 35, 45, 46, 53, and 58 were rejected under 35 U.S.C. § 103(a) based on the ‘042 patent and Kochinke. Kochinke is cited solely for an alleged teaching of “more than one therapeutic agent contained in different adhesive matrices to deliver mixture of therapeutic agents.” Office Action at 10. Kochinke, however, fails to



cure the above-noted deficiencies of the '042 patent discussed above with respect to independent claims 1, 27, and 56, from which each of claims 19-26, 28-30, 35, 45, 46, 53, and 58 respectively depends. Applicant respectfully submits that, therefore, the § 103(a) rejection of claims 19-26, 28-30, 35, 45, 46, 53, and 58 should be withdrawn.

### **Conclusion**

For at least the foregoing reasons, Applicant respectfully submits that each of independent claims 1, 27, 54-56, 61, and 68 is allowable. Each of claims 5-26, 28-30, 35-53, 57-60, and 62-67 ultimately depends from one of these allowable independent claims and, therefore, should be allowable for at least the same reasons that the respective claim from which it depends is allowable. Additionally, these dependent claims include further limitations that distinguish from the cited art.

The Office Action contains a number of statements reflecting assertions and/or allegations concerning the claims and/or cited art. Regardless of whether any such statement is identified above, Applicant declines to subscribe to any assertion or allegation in the Office Action.

In view of the above, Applicant respectfully requests that the rejections be withdrawn and that the application be allowed.

Please grant any additional extensions of time required to enter this response  
and charge any required fees to our Deposit Account No. 06-0916.

Respectfully submitted,

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